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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,906	11/01/1999	JAMES PAUL WEST	PW-1	7934

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EXAMINER

SHERRER, CURTIS EDWARD

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/17/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/430,906

Applicant(s)
West et al.

Examiner
Curtis E. Sherrer

Art Unit
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 16, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) 18-20, 25-27, 31, 32, and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21-24, 28-30, and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17, 21-24, 28-30 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-17, 21-24, 28-30 and 33 are indefinite because the scope of the phrase “sufficient quantity of an ethanol” is not known. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 1-17, 21-24, 28-30 and 33 are indefinite because the scope of the phrase “recreationally relevant” is not known. While applicants cite to portions of the instant specification, said portions do not provide definite boundaries as to what would be encompassed by said phrase.

Claims 2-4 are indefinite because the scope of the phrase “easily transportable” is not known. Applicants cite to portions of the specification to provide meaning and substance to said phrase. One cannot define a phrase using terms or phrases that are themselves indefinite. It is

not known what “sufficient rigidity to sustain packaging” encompasses. It is not known under what circumstances the packaging is subjected to.

Claim 4 is indefinite because the scope of the phrase “easily rupturable” is not known. Applicants refer to the specification to define the phrase. These passages merely show two instances where the capsule is considered to be easily ruptured. These examples do not provide the full scope necessary to make the claim definite.

Claim 5 is indefinite because the scope of the phrase “similarly shaped” is not known. Applicants state that “the shape of a capsule is so well recognized in the art that there would be little confusion with determining whether another object is shaped like a capsule.” Applicants provide no evidence of such a conclusion.

Claim 6 is indefinite because the scope of the phrase “approximately” is not known. In the cases cited by applicants, the phrases were determined to have a definite scope. Applicants have provided no definite scope to the claim.

Claims 8-12 are indefinite because the scope of the phrase “about” is not known. See above.

Claim 15 is indefinite because the scope of the phrases “optionally” and “easy swallowing” is not known. Again, applicants provide a few examples but these do not clearly define the metes and bounds of the claim, but merely a few members that reside within the broad scope of the claim.

Claim 17 is indefinite because the scope of the phrase “sufficiently small to permit easy passage” is not known. It is not clear what “easy passage” would include.

Claim 21 is indefinite because the scope of the phrase “various concentrations” is not known. Applicants do not clearly define the phrase for the reasons set forth above.

Claim 28 is indefinite because the scope of the phrase “appearance of a garnish” is not known. Applicants do not define or provide specificational basis for the phrase “all such garnishes commonly added to ‘dress up’ an alcoholic beverage.”

Claim 29 is indefinite because the scope of the phrase “appearance of an olive” is not known. It is still not known what phrase encompasses with respect to size, color, etc.

Claim 30 is indefinite because the scope of the phrase it appears that the concentration of alcohol is linked to the dissolution of the outer coating and it is unclear how what is sealed inside the capsule can affect the dissolution of the capsule. For clarification purposes, the phrase is the claim.

Claim 31 is indefinite because the scope of the phrases “about” “optionally and “substantially” is not known. See above.

Claim Rejections - 35 USC § 102

. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

Claims 1-5, 7-10, 13-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Brox (U.S. Pat. No. 4,888,239) for the reasons set forth in the last Office Action.

Because of the instant claims broad scope, Brox is not excluded as anticipatory prior art. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., alcohol percentage) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Brox is directed to more than just pharmaceutical applications, i.e., foods and dietary supplements.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Sanker et al. (U.S. Pat. No.

5,620,707)(hereinafter Sanker) in light of Handbook of Perfumes and Flavors, page 280) for the reasons set forth in the last Office Action.

Applicants state that the instant teaching cannot anticipate the claims because it teaches that it must first be placed in a beverage to dissolve and release its content. In response, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicants assert that “such flavorings for coffees and other confections have historically been of such a low total amount that inebriation effects . . . are essentially negligible.” But applicants provide no evidence to support their opinion. Further, drinks such as Irish coffee inherently contain large amounts of ethanol.

Lastly, applicants state that “use of ethanol based compositions in a chewable, ingestible capsule form . . . produces a new, unexpected, and useful function as required by the Courts.” But applicants are not claiming a process or use, but a product.

Claim Rejections - 35 USC § 103

Claims 6 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanker for the reasons set forth in the last Office Action.

The claims broadly recite shapes and until these shapes are more fully and definitely defined, the claims are interpreted broadly. And again, because the claims are directed to products, the intended use of said products is not a limitation.

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanker in view of McMahon et al (U.S. Pat. No. 5,466,460) for the reasons set forth in the last Office Action.

Response to Arguments

Applicant's arguments filed 01/10/02 have been fully considered but they are not persuasive. See comments above.

Conclusion

No claim is allowed.

This is a CPA of applicant's Application No. 09/430,906. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the

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grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Curtis E. Sherrer
Primary Examiner
December 16, 2002